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10/807,026	03/22/2004	Don Wadley	200315040-1	2236

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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12/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/807,026	Applicant(s) WADLEY, DON	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13, 25, 26, 45 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-21, 27-37, 39-41, 47 and 48 is/are rejected.
- 7) ☒ Claim(s) 9-11, 22-24, 38 and 42-44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species I in the reply filed on 9/22/08 is acknowledged. The traversal is on the ground(s) that the Species are not mutually exclusive. This is not found persuasive. Note that the term "mutually exclusive" is defined as "a situation involving two or more events possibilities, etc., in which the occurrence of one precludes the occurrence of the other" (www.dictionary.com). Three Species according to Figs. 3~6 (as presented in the Restriction filed on 8/22/08) are mutually exclusive since the occurrence of each Species precludes from the occurrence of the other. For example, Species I require the printing device to be programmed with a predetermined threshold that governs whether or not the message should be sent to the server. On the other hand, Species II & III require the server, not the printer, to be programmed with a predetermined threshold to suspect the counterfeiting cartridge. Furthermore, Species II & III require the messages to be sent when (that is, every time) the cartridge is installed or each time the printer is powered up. Since Species I do not transmit the message each time the cartridge is installed or every time the printer is powered up, it is clear that they are mutually exclusive to each other.

The requirement is still deemed proper and is therefore made FINAL.

In light of the foregoing explanation, Examiner finds that the claims correspond to the Species as follows.

Generic to all Species: Claims 1-8, 14-21, 27-37, 39-41, 47 and 48;

Species I: Claims 9-11, 22-24, 38 and 42-44;

Generic to Species I and II: Claims 12, 13, 25, 26, 45 and 46.

Since Claims 12, 13, 25, 26, 45 and 46 are drawn to non-elected Species, these claims are withdrawn from the consideration.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of “comparing said date information with said current date when a print cartridge is installed” (claims 11, 24 and 44) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Perhaps, S136 of fig. 4 should be amended -- “Print cartridge installed? (136)” --.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims are objected to because of the following informalities:

Claim 6, line 3, “a print cartridge” should be -- said print cartridge --;

Claim 11, line 2, “a print cartridge” should be -- said print cartridge --;

Claim 24, line 2, “a print cartridge” should be -- said print cartridge --;

Claim 27, line 3, “a population of monitored printing device” should be -- a population of monitored printing devices --;

Claim 27, line 6, “monitored printing devices” should be -- said monitored printing devices --;

Claim 44, line 2, “a print cartridge” should be -- said print cartridge --;

Claim 47, line 4, “a population of monitored printing device” should be -- a population of monitored printing devices --; and

Claim 47, line 7, “monitored printing devices” should be -- said monitored printing devices --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 27 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said messages". There is insufficient antecedent basis for this limitation in the claim.

With respect to claims 27 and 47, the claims recites the limitation of "said messages include[ing] date information from a print cartridge installed in a monitored printing device". It is unclear if all messages include date information of one particular print cartridge installed in one particular monitored printing device. Does a population of monitored printing devices know the date information of a print cartridge installed in other monitored printing device in order to send said messages?

Clarification/explanation from the Specification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4-8, 14-16, 18-21, 27, 29-32, 35-37, 39-41 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Takemoto U.S. Patent No. 6,625,402.

With respect to claim 1, Takemoto discloses a system for detecting potential counterfeiting of print cartridges comprising at least one printing device programmed to: read date information from an installed print cartridge (col. 3, lines 46-65), and transmit a message regarding said date information to a monitoring server (col. 5, lines 15-19).

With respect to claim 2, Takemoto discloses the system of claim 1, wherein said monitoring server is programmed to analyze said messages from monitored printing devices for patterns indicative of counterfeiting of print cartridges (col. 5, lines 20-30).

With respect to claim 4, Takemoto discloses the system of claim 1, wherein the printer and the server are communicated via the Internet (col. 2, line 47). Note that it is inherent that the IP/MAC address of the source device is used in the Internet communication. Furthermore, each time the message/data packet is sent via the Internet, the IP/MAC address is inherently included in the message/data packet. Therefore, when the message according to Takemoto is sent from the printer to the server, the IP/MAC address of the source, which inherently is stored in the printer, (the printer) is sent to the server.

With respect to claim 5, note that the IP/MAC address of the printer represents a location of the printing in the network.

With respect to claim 6, Takemoto discloses the system of claim 1, wherein said printing device further comprises an electronic connection configured to be connected to an electronic memory unit on said print cartridge installed in said printing device (col. 4, lines 21-26).

With respect to claim 7, Takemoto discloses the system of claim 2, wherein said printing device has a connection to the Internet over which said message is transmitted to said monitoring server (col. 2, lines 44-49).

With respect to claim 8, Takemoto discloses the system of claim 2, wherein said monitoring server saves messages from monitored printing devices in memory (col. 5, lines 21-30). Note that the received information must be stored either permanently or temporarily in the server in order determine whether or not the cartridge is a genuine product.

With respect to claim 14, Takemoto teaches a method for detecting potential counterfeiting of print cartridges comprising transmitting a message regarding date information stored on a print cartridge installed in a printing device (col. 3, lines 46-65), said message being transmitted to a monitoring server (col. 5, lines 15-19).

With respect to claim 15, Takemoto teaches the method of claim 14, further comprising reading said date information from a memory on said print cartridge (col. 3, lines 46-65).

With respect to claim 16, Takemoto teaches the method of claim 14, further comprising analyzing messages from monitored printing devices with said monitoring server for patterns indicative of counterfeiting of print cartridges (col. 5, lines 20-30).

With respect to claim 20, Takemoto teaches the method of claim 14, further comprising transmitting said message to said monitoring server from said printing device over the Internet (col. 2, lines 44-49).

With respect to claim 21, Takemoto teaches the method of claim 14, further comprising saving messages from monitored printing devices in memory on said monitoring server (col. 5, lines 21-30). Note that the received information must be stored either permanently or temporarily in the server in order determine whether or not the cartridge is a genuine product.

With respect to claim 27, Takemoto discloses a system for detecting potential counterfeiting of print cartridges comprising a monitoring server programmed to:

receive messages from a population of monitored printing device (col. 5, lines 15-19), wherein each said message includes date information from a print cartridge installed in a monitored printing device (col. 3, lines 46-65), and

analyze said messages from monitored printing devices for patterns indicative of counterfeiting of print cartridges (col. 5, lines 20-30).

With respect to claim 31, Takemoto discloses the system of claim 27, wherein said monitoring server is configured for connection to the Internet and receives said messages over the Internet (col. 2, lines 44-49).

With respect to claim 32, Takemoto discloses a system for detecting potential counterfeiting of print cartridges comprising:

means for transmitting a message from a printing device (col. 5, lines 15-19) regarding date information stored on a print cartridge installed in a printing device (col. 3, lines 46-65); and

means for receiving said message and analyzing said message and other messages (other messages already stored in the server for the comparison/determination) to identify patterns indicative of counterfeiting of print cartridges (col. 5, lines 20-30).

With respect to claim 37, Takemoto discloses the system of claim 32, wherein said means for transmitting said message comprise the Internet (col. 2, lines 44-49).

With respect to claim 39, Takemoto discloses processor-readable instructions stored on a medium for storing processor-readable instructions, said instructions, when executed, causing a printing device to:

read date information from an installed print cartridge (col. 3, lines 46-65), and transmit a message regarding said date information to a monitoring server (col. 5, lines 15-19).

With respect to claim 47, Takemoto discloses computer-readable instructions stored on a medium for storing computer-readable instructions, said instructions, when executed, causing a monitoring server to:

receive messages from a population of monitored printing devices (col. 5, lines 15-19), wherein said messages include date information from a print cartridge installed in a monitored printing device (col. 3, lines 46-65), and

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analyze said messages from monitored printing devices for patterns indicative of counterfeiting of print cartridges (col. 5, lines 20-30).

With respect to claims 18, 19, 29, 30, 35, 36, 40 and 41, arguments analogous to those presented for claims 4 and 5, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto as applied to claim 1 above, and further in view of Parry et al. U.S. Patent Application Pub. No. 2002/0188860 (hereinafter Parry).

With respect to claim 3, Takemoto discloses a system of claim 2, but it does not explicitly disclose that said monitoring server is programmed to automatically transmit notification of detection of a pattern indicative of counterfeiting of print cartridges.

Parry, the same field of endeavor of detecting counterfeiting cartridges using the cartridge ID, discloses means for transmitting notification of the detection to the cartridge supplier/producer.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the server of Takemoto to include the means for transmitting the notification to the supplier upon detecting the counterfeiting cartridge as taught by Parry.

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The suggestion/motivation for doing so would have been to inform about the counterfeiting cartridges in the market to the suppliers.

Therefore, it would have been obvious to combine Takemoto with Parry to obtain the invention as specified in claim 3.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto as applied to claim 14 above, and further in view of Parry.

With respect to claim 17, arguments analogous to those presented for claim 3, are applicable.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto as applied to claim 27 above, and further in view of Parry.

With respect to claim 28, arguments analogous to those presented for claim 3, are applicable.

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto as applied to claim 32 above, and further in view of Parry.

With respect to claim 34, arguments analogous to those presented for claim 3, are applicable.

10. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto as applied to claim 47 above, and further in view of Parry.

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With respect to claim 48, arguments analogous to those presented for claim 3, are applicable.

11. Claims 4, 5, 18, 19, 29, 30, 35, 36, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto.

With respect to claims 4 and 5, even if using IP/MAC address in the Internet communication is not inherent in the Internet communication, it is certainly obvious to one of ordinary skill in the art at the time of the invention to use IP protocol to communicate between the printer and the server in the Internet network. Again, since it inherently includes the IP/MAC address of the source device in the message, it would have been obvious to obtain the invention as specified in claims 4 and 5.

With respect to claims 18, 19, 29, 30, 35, 36, 40 and 41, arguments analogous to those presented for claims 4 and 5, are applicable.

Allowable Subject Matter

12. **Claims 9-11, 22-24, 38 and 42-44** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

December 18, 2008